

REMARKS

Reconsideration and allowance are respectfully requested.

The amendments proposed in this Response address the 35 U.S.C 112, second paragraph issues on pages 2-5 of the office action. No new matter has been added. Entry and allowance are requested.

Claims 1-36 are patentable under 35 U.S.C. 103(a) over Walters (US 5,378,084) in view of Fildan (US 6,056,625).

Walters relates to a backpack system in which the center of gravity is adjusted by providing a wide waistband on a front side of a vest. Walters describes the vest having upper strap coupling 43 with a loop 44 for feeding a nonstretchable strap 45 through the loop 44 and through coupling 43 securing strap 45 to the jacket 10. Lateral loop 46 covers the lower strap 48 which has a first end attached and adjustable with respect to the upper coupling 43. Strap 48 has a second end attached to a ring 50 that may be tucked into a pocket in the jacket 10 for streamlining.

Nothing in Walters teaches, describes, or suggests the claimed strap forming a segment with two portions with the first portion permanently attached and the second portion having an end insertable in a widened ring and being retained therein. Walters teaches exactly the same device that the present invention seeks to avoid. This has been clearly pointed out in under "Background..." of the present specification. Walters teaches

having a free end of the strap inserted into a pocket. The present invention seeks to avoid that by providing the claimed strap which does not have a free end that impinges on any activity of the user.

Fildan, from an unrelated art, is being relied on as teaching a brassiere slider which limits the sliding of the frame on a strap. The slider has a recessed crossbar to enable the assembly to lie flat and to avoid slide movement of the slider on the strap. Fildan is non-analogous art and is not available as a reference against the present claims. See In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992): "In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." citing In re Deminski, 230 USPQ 313, 315 (Fed. Cir. 1986).

"The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness." In re Oetiker, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

Firstly, there is no showing as to how one of ordinary skill in the Walters backpack art would refer to Fildan's brassiere clasps for making a mental jump as proposed by the Examiner. Secondly, the Examiner's use of the Fildan slider to replace the Walters ring, still does not result in the claimed invention

because the so-called widened member/ring referenced by the Examiner in Walters is not found either in column 6, lines 31-68; nor in column 7, lines 1-60 and nor in Figures 1-8. The Examiner is respectfully requested to identify the element number which the Examiner sees to represent Walters widened member/ring or at least provide Applicant with a marked-up copy of the figures showing the so-called Walters widened member/ring. Because Applicant is unable to find the basis for the Examiner's contention, Applicant is unable to adequately rebut such presumption barring speculation about the possible evidence being relied on by the Examiner.

The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner. The 'prima facie case' notion ... was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections ... the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness. (emphasis added)
In re Oetiker, 25 USPQ2d 1443, 1447 (Fed. Cir. 1992)
(Plager, J., concurring); see In re Piasecki, 233, USPQ 785, 788 (Fed. Cir. 1984).

In any case, the combined teachings of the two references do not describe, teach or render obvious the claimed invention. The present invention relates to a device for retaining free loose ends of tightening or fastening straps (5) or belts, particularly in articles for wearing, comprising a strap or belt (5) including a segment and opposite free ends. One free end is a part of the segment of the strap or belt (5) which is secured by another free end to a first part (101) of the article. The first part (101) is connectable to a second part (102) of the article by the

segment. The second part (102) is connected in an intermediate portion of the segment of the strap or belt. The segment of the strap or belt (5) is divided into a free loose portion (205) and into a portion (105) for connecting the first and second parts (101, 102) of the article. The segment of the strap or belt (5) is connected to the first part (101) in a permanent manner. A widened member (7, 8, 10) is provided for fastening and retaining an end of the segment of the strap or belt (5) to the corresponding first part (101). The widened member (7) has an opening through which the free loose portion (205) of the strap or belt (5) passes and is retained. Neither Walters nor Fildan, alone or in combination, teaches or suggests those features, and thus, cannot render the invention obvious.

Claims 2-36 are also patentable over the references.

The office action does not provide any basis for the rejection of each and every dependent claim over the references.

Applicant finds no basis in the office action for the rejection of every feature in each of the present claims under 35 U.S.C. 103(a) over a combination of several references.

Applicant is unable to address such ambiguity because it would be mere speculation to decide the Examiner's clear intent in the rejections of record. Therefore, all the claims are patentable over the references of record.

The Federal Circuit has held that the patent office is obligated to make necessary findings and to provide an

administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusion. In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). The decision "must be justified within the four corners of the record." In re Gartside, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000). The Examiner has neither made the necessary findings nor provided any reasoning for the arbitrary conclusion of obviousness even though the references do not teach or suggest the claimed features. Therefore, Applicant's previously filed Appeal Brief, as well as this Substitute Appeal Brief, complies with all the requirements of 37 C.F.R. 1.192(c).

"Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. ... Office policy is to follow Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), in the consideration and determination of obviousness under 35 U.S.C. 103. See MPEP § 2141.

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness. See MPEP § 2142. The record in this case reflects that the Examiner has not provided any evidence that forms the basis for the rejection of every dependent claim. Therefore, the Examiner has not presented a prima facie case of obviousness and applicant is under no obligation to submit evidence of nonobviousness as

dictated by MPEP § 2142.

To establish a prima facie case of obviousness three basic criteria must be met. See MPEP § 2143. Graham, supra, is interpreted as continuing to place "the burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103." In re Piasecki, 223 USPQ 785, 788 (Fed. Cir. 1984) quoting from In re Warner, 154 USPQ 173, 177 (CCPA 1967).

MPEP § 706.02(j) provides that, for a rejection under 35 U.S.C. 103, the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column pr page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied references,
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

The Examiner has failed to set forth any of the above requirements for the dependent claims. Therefore, the examiner has failed to establish a prima facie case of obviousness.

MPEP § 706.02(j) further provides:

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given a fair opportunity to reply.

The record in this case reflects that there has been no proper communication of the basis for the rejection of every feature of every dependent claim and thus, applicant has not been given a fair opportunity to rebut non-existent evidence that form

basis for the rejections.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 165 USPQ 494, 496 (CCPA 1970). See MPEP § 2143.03.

If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 25 USPQ2d 1443, 1447 (Fed. Cir. 1992) citing In re Grabiak, 226 USPQ 870, 873 (Fed. Cir. 1985).

In fact, the office action does not provide any basis for the rejection of each of the features in every dependent claim and therefore Applicant is unable to determine the Examiner's basis for the rejection of each of the claims to adequately rebut the rejections. Therefore, as dictated by Oetiker "without more applicant is entitled to grant of the patent."

Nothing in the references, either singly or in combination, teaches or suggests the claimed features. Therefore, the references cannot anticipate nor render obvious the present invention as claimed.

Since Applicant has presented a novel, unique and non-obvious invention, reconsideration and allowance are respectfully requested.

Respectfully,



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